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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/613,334 | 07/03/2003 | Joseph Saladino | IOI-453 | 5122 |
| 37235 | 7590 | 10/04/2004 | EXAMINER | |
| ZIMMER TECHNOLOGY, INC. 150 N. WACKER DRIVE SUITE 1200 CHICAGO, IL 60606 | | | PREBILIC, PAUL B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3738 | |

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---|--|
| Office Action Summary | Application No. 10/613,334 | Applicant(s) SALADINO ET AL. <i>CS</i> | |
| | Examiner Paul B. Prebilio | Art Unit 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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No restriction requirement between the various species disclosed and claimed is being given at this time. However, the Examiner reserves the right to give a restriction requirement in the future.

Claim Objections

Claims 7, 11, 12, and 14 are objected to because of the following informalities:

Regarding claim 7, the language "include . . . and 6 mm" appears to be an improperly stated Markush group; see MPEP 2173.05(h). The Examiner suggest changing this language to read ---include . . . or 6 mm--- or ---selected from the group consisting of . . . 6 mm--- is this is what was intended.

Regarding claim 11, line 2, the language "selected from" is an incomplete Markush statement; see MPEP 2173.05(h). The Examiner suggests replacing this language with ---selected from the group consisting of--- in order to overcome this objection.

Regarding claim 12, line 1 and claim 14, line 2, the language "including" is confusing since the element preceding this term had features already presented earlier in this claim or the base claim. The Examiner suggesting changing "including" to ---further including--- in order to overcome this objection.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 8-10, 15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Fallin (US 5,108,452). Fallin anticipates the claim language where the femoral head as claimed is met by the head (27) of Fallin, and the neck is met by one of the sleeves (45) closest to the head (27); see Figures 1 to 5 and column 6, lines 13-68.

Regarding claim 3, the bore as claimed is the conical inner surface (47) of Fallin.

Regarding claims 8 and 18, the adjustment mechanism as claimed is met by the sleeve (45) between the sleeve (45) directly contacting the head (27) and the neck (14) of Fallin.

Regarding claim 15, the sleeves of Fallin are considered to be ring shaped to the extent that this language can be given patentable weight.

Claims 1-5, 8, 13, 14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Subba Rao et al (US 2001/0051831). Subba Rao anticipates the claim language where the femoral head as claimed is the ball member of Subba Rao, and the neck as claimed is the neck (40) and/or coupling member (26) of Subba Rao; see the abstract, Figures 1 and 2, and paragraphs [0032] to [0037].

Regarding claim 8, the neck as claimed is the neck (40) of Subba Rao, the adjustment mechanism is coupling member (26), and the head is head (27).

Regarding claim 17, the shoulder as claimed is flange (62) which would abut the coupling member if it were adjusted as such; see Figure 4B where if the spring were fully compressed then the coupling member would abut the shoulder.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 11, 12, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fallin (US 5,108,452). Fallin meets the claim language as explained in the Section 102 rejection above but fails to disclose offsets of 1 mm increments or the number of offsets as claimed; Fallin calls his offsets sleeves. However, since Fallin discloses the concept of multiple offsets (see *supra*), it is the Examiner's position that it would have been considered prima facie obvious to have any number of sleeves of various sizes and quantities in order to make the device fit as many individuals as possible. This would improve the usefulness of the device. Moreover, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make four or more sleeves of thickness from 1 mm to 6 mm because Applicants have not disclosed that doing so provides some advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicants' invention to perform equally well because it would be able to fit a wide variety of patients. Therefore, it would have been an obvious matter of design choice to modify Fallin to obtain the invention as specified in the claims.

Allowable Subject Matter

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul B. Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
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